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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,238	06/27/2003	Jean D. Paoli	301662.01	7738
22971 7590 12/15/2008 MICROSOFT CORPORATION ONE MICROSOFT WAY REDMOND, WA 98052-6399				
EXAMINER NGUYEN, LE V				
ART UNIT 2174		PAPER NUMBER		
NOTIFICATION DATE 12/15/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

roks@microsoft.com  
ntovar@microsoft.com

### Office Action Summary

**Application No.**

10/609,238

**Applicant(s)**

PAOLI ET AL.

**Examiner**

LE NGUYEN

**Art Unit**

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8-14 and 63-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-14 and 63-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This communication is responsive to an amendment filed 10/30/08.
2. Claims 1-6, 8-14 and 63-65 are pending in this application; and, claims 1, 14, 63 and 64 are independent claims. Claims 7,15-62 and 66-83 have been cancelled; and, claims 13, 9, 14 63 and 64 have been amended .

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 8-14, 63 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaker et al. ("Kaker", US 2001/0037218 A1) in view of Capps (US 5,666,502).

As per claims 1 and 14, Kaker teaches a method and computer-readable medium comprising computer-executable instructions that perform the method comprising: receiving input to open a data file having a solution (par. [0125]; PDF file opens in response to user input); discovering/deploying, without user interaction, the solution, i.e. discovering/deploying a solution (par. [0125]; Prescription Form/solution provides data for automatic form filling); displaying, by opening the data file with the solution, an electronic form having operable fields (par. [0125]; users can complete the

form); and enabling a user to enter data into the operable fields of the electronic form (par. [0125]; space in an on-screen form are provided in order for users to enter, for example, a signature to complete the form). Kaker does not explicitly disclose defining the availability of one or more actions to the user when entering the data into each operable field of the electronic form. However, defining the availability of one or more actions to the user when entering the data into each operable field of the electronic form is well known as taught by Capps (figs. 5B and 13A-14C; col. 10, line 45 through col. 11, line 14; col. 12, lines 51-53; col. 16, line 23 through col. 17, line 7). It would have been obvious to an artisan at the time of the invention to include the method of Capps with the method of Kaker to alleviate the user from having to type in or otherwise enter the data and, therefore, enter data with greater ease.

As per claim 2, the modified Kaker teaches a method and computer-readable medium comprising computer-executable instructions that perform the method comprising receiving data entered into the selected operable field of the electronic form and altering the data in the data file so as to correspondingly reflect the data received (figs. 5B and 13A-14C; blank field to fields with data).

As per claim 3, the modified Kaker teaches a method and computer-readable medium comprising computer-executable instructions that perform the method wherein the availability of one or more actions to the user concurs with an event elected from the group consisting of: an association of an input device being used by the user with one said operable field; a pen/stylus/cursor position corresponding to an input device being used by the user is proximal to one said operable field; one said operable field is

selected by the user by use of an input device; one said operable field on the electronic form is made to be an active field by operation of an input device being used by the user; specific conditions are met wherein specific conditions are met with respect to the data in the one said operable field; when the user's mouse pointer for an input device rests over, within, or proximal to an editable region of one said operable field; when the user's mouse pointer for an input device rests over, within, or proximal to an editable region of one said operable field and the mouse is clicked one or more times (Capps: fig. 2 and col. 7, lines 51-59).

As per claim 4, the modified Kaker teaches a method and computer-readable medium comprising computer-executable instructions that perform the method wherein each said action is selected from the group consisting of: a request for *one or more of* a display of a menu and an activation of a menu item of a menu (par. [0092] and [0202]); an editing operation with respect to data in *at least one* said operable field that is one or more of an undo function, a redo function, a copy function, a cut function, a paste function, an insertion of a hyperlink, and a carriage return or line feed function; performing a character formatting operation with respect to data in at least one said operable field that is one or more of a boldface, an italics, an underlining, a change of font size or font color, character spacing, and text effects (par. [0052]); and adding, entering, updating or deleting, with respect to at least one said operable field, one or more of a repeating operable field, an optional operable field, a spreadsheet, a table, a row or a column in a table, a text box, multiple spaces, a header, a footer, an image, a graphic, a picture, a link to an image, a link to a graphic, a link to a picture, single line

plain text, multi-line plain text, single line formatted text, multi-line formatted text, rich text, a whole number, a decimal, a true/false distinction, a date, and a time (par. [0052]). Kaker does not explicitly disclose the menu being a tool bar wherein users can activate a command tool. Official Notice is taken that menus in a tool bar format wherein users can activate a command tool are well known in the art. It would have been obvious to an artisan at the time of the invention to incorporate a tool bar format wherein users can activate a command tool to the method of Kaker in order to provide users with an implementation preference.

As per claim 5, the modified Kaker teaches a method and computer-readable medium comprising computer-executable instructions that perform the method wherein the availability of each said action is determined on the basis of the context of each said operable field of the electronic form with respect to at least one other said operable field of the electronic form (Cappps: figs. 5B and 13A-14C; col. 10, line 45 through col. 11, line 14; col. 16, line 23 through col. 17, line 7).

As per claim 6, although Kaker teaches a method and computer-readable medium comprising computer-executable instructions that perform the method and computer-readable medium comprising computer-executable instructions that perform the method comprising discovering the solution (par. [0092]), Kaker does not explicitly disclose discovering a solution identifier in the data file, computing a special name from the solution identifier, and discovering the solution using the special name. Official Notice is taken that having an identifier and looking up the name from a look up table such as in the case wherein a hash map computes a name from the identifier is well

known in the art. It would have been obvious to an artisan at the time of the invention to incorporate a data file containing an identifier wherein from the identifier, a name of a solution is computed to the method of Kaker given that saving as an identifier or hash rather than the actual name is more compact and, therefore, saves space.

As per claim 8, although the modified Kaker teaches a method and computer-readable medium comprising computer-executable instructions that perform the method comprising a data file (Kaker: par. [0125]), the modified Kaker does not explicitly disclose the file being written in XML. However, files written in XML are well known in the art (see col. 2, lines 32-40 of Hitchcock et al., US 6,345,278 B1). It would have been obvious to an artisan at the time of the invention to incorporate such an implementation with the method of the modified Kaker given that it is easily interpretable both by people and machine and given that it saves time when used in conjunction with an existing parser rather than having to build one from scratch. KSR Int'l Co. v. Teleflex, Inc., 127 S. Ct. 1727, 1739-41, 82 USPQ2d 1385, 1395, 1396 (2007) quoting In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336-37 (Fed. Cir. 2006); Also, as clarified in KSR, 127 S. Ct. 1727 at 1742, 82 USPQ2d at 1397 (2007).

As per claim 9, the modified Kaker teaches a method and computer-readable medium comprising computer-executable instructions that perform the method wherein: the solution includes a presentation application that includes the electronic form and the presentation file contains logic to gives the display of the electronic form a graphical, visual representation of the operable fields (figs. 2, 4-8, 17-25).

As per claim 10, although the modified Kaker teaches a method and computer-readable medium comprising computer-executable instructions that perform the method comprising a presentation application (Kaker: par. [0125]; Capps: figs. 5B and 13A-14C), the modified Kaker does not explicitly disclose the presentation application being written in XSLT. Official Notice is taken that presentation applications being written in XSLT is well known in the art. It would have been obvious to an artisan at the time of the invention to incorporate the method of having presentation applications written in XSLT with the method of the modified Kaker given in order to provide a nice format and transform, for example, XML to other formats given that some devices support only certain formats.

As per claim 11, the modified Kaker teaches a method and computer-readable medium comprising computer-executable instructions that perform the method wherein the solution includes a logic application for ensuring the validity of the received data that is entered into the operable fields of the electronic form (Kaker: par. [0058], [0073] and [0121]).

As per claim 12, although the modified Kaker teaches a method and computer-readable medium comprising computer-executable instructions that perform the method comprising a logic application (Capps: figs. 6(A-B); col. 8, lines 48-60), the modified Kaker does not explicitly include an XML schema. However, the implementation of XML and generating an XML schema is well known in the art for many years. It would have been obvious to an artisan at the time of the invention to incorporate such well known implementations with the method of the modified Kaker in order to put constraints on

how data is represented to make it easier for different programs to deal with the same data. See *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1739-41, 82 USPQ2d 1385, 1395, 1396 (2007) quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336-37 (Fed. Cir. 2006); Also, as clarified in *KSR*, 127 S. Ct. 1727 at 1742, 82 USPQ2d at 1397 (2007).

As per claim 13, although the modified Kaker teaches a method and computer-readable medium comprising computer-executable instructions that perform the method comprising an electronic form (Kaker: par. [0125]; Capps: figs. 5B and 13A-14C)), the modified Kaker does not explicitly disclose it being written in XHTML. Official Notice is taken that using XHTML is well known in the art. It would have been obvious to an artisan at the time of the invention to incorporate XHTML to the method of the modified Kaker in order to display such things as forms in browsers wherein displaying in browsers are additionally beneficial in that it does not require additional installation of software on desktops which would require additional support costs and that it is flexible, allowing users to access such things as forms from anywhere.

Claim 63 is similar in scope to claim 2 and is therefore rejected under similar rationale.

Claim 64 is similar in scope to claim 3 and is therefore rejected under similar rationale.

5. Claim 65 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaker et al. ("Kaker", US 2001/0037218 A1) in view of Capps (US 5,666,502) as applied to claim 63, and further in view of Turpin (US 5,640,501).

As per claim 65, the modified Kaker teaches a method and computer-readable medium comprising computer-executable instructions that perform the method wherein each said action is selected from the group consisting of: displaying a menu containing one or more menu items with the electronic form (Capps: fig. 5B, menu ); displaying a toolbar containing one or more command tools with the electronic form (fig. 3; col. 7, lines 7-15; printed strip of material 128 include a number of indicia 130 so that when a stylus is engaged over one of the indicia 130, the computer responds to the contact as if the indicia were a "button" wherein a "button" can be an image or an electro-mechanical button); selecting a menu item from a menu that is displayed with the electronic form (Capps: fig. 5B; col. 10, line 45 through col. 11, line 14); selecting a command button/tool from a tool bar that is displayed with the electronic form (Capps: fig. 5B, element 130); and adding, entering, updating or deleting, with respect to a data-entry field in the electronic form, one or more of a repeating data-entry field, an optional data-entry field, a spreadsheet, a table, a row or a column in a table, a text box, multiple spaces, a header, a footer, an image, a graphic, a picture, a link to an image, a link to a graphic, a link to a picture, single line plain text, multi-line plain text, single line formatted text, multi-line formatted text, rich text, a whole number, a decimal, a true/false distinction, a date, and a time (Capps: fig. 5B; entering either one of a single line plain text or single line formatted text).

Although the modified Kaker teaches an editing operation with respect to data in a data-entry field in the electronic form (Kaker: par. [0125]), the modified Kaker does not explicitly disclose either an editing operation that is one or more of an undo function, a

redo function, a copy function, a cut function, a paste function, an insertion of a hyperlink, and a carriage return or line feed function nor a character formatting operation with respect to data in a data-entry field in the electronic form that is one or more of a boldface, an italics, an underlining, a change of font size or font color, character spacing, and text effects. However, such editing and formatting operations are well known in the art as taught by Turpin (fig. 6; col. 16, line 46 through col. 17, line 46; functions include, for example, undo and formatting includes, for example, font size; see also Nishiyama (col. 6, lines 36-50). It would have been obvious to an artisan at the time of the invention to include the method of Turpin with the method of the modified Kaker so that forms may be customized and modified to suit the needs of the user such as by displaying an entry item in a conspicuous manner.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-6, 8-14 and 63-65 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tondevoid et al. (US 5,410,646) teach creating, processing and storing forms electronically.

Pennell et al. (US 7,206,998 B2) teach automatically learning information used for electronic form-filling.

Hitchcock et al. (US 6,345,278 B1) teach a universal forms engine comprising comparing applicant data in the completed form data fields with permissible values (claim 37).

Lu et al. (US 2002/0186249 A1) teach mapping the fields in a wallet database to the fields in a merchant file so that each order form may be automatically filed out during an on-line shopping session (par. 0144)).

Nishiyamam et al. (US 6,421,693 B1) teach automatically fill entry items of documents.

Markus et al. (US 6,490,601 B1) teach automatic insertion of data into electronic forms on a user computer.

Kennedy et al. (US 6,651,217 B1) teach populating forms with previously used data values.

Bertran et al. (US 5,805,158) teach copying predicted input between computer systems.

Miller (US 5,805,911) teaches word prediction system.

Treibach-Heck et al. (US 7,296,221 B1) teach remote automatic reporting and verification of forms.

Scharmer (US 5,640,577) teaches automated partial forms completions.

Millard et al. (US 5,495,565) teach an integrated form document editor with form descriptor table, background bitmap, graphics editor and text editor, composite image generator and intelligent autofill.

Furst (US 6,297,819 B1) teaches parallel Web sites.

Atlas et al. (US 6,208,339 B1) teach user-interactive data entry display system with entry fields having distinctive and changeable autocomplete.

### ***Inquires***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lê Nguyen whose telephone number is **(571) 272-4068**. The examiner can normally be reached on Monday - Friday from 7:00 am to 3:30 pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached at (571) 272-4124.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lvn

Patent Examiner

December 1, 2008

/Stephen S. Hong/

Supervisory Patent Examiner, Art Unit 2178